REMARKS

Claims 1-5, 7, 9, 11, 13-18, 20-22, 24, 26-31, 48-52 and 55-58 are currently amended to correct typographical errors and/or more particularly point out and distinctly claim the present invention in order to advance this case toward issuance. These amendments are fully supported by the specification. *See, e.g.*, Page 5, Lines 12-21; Page 7, Line 18 - Page 8, Line 17; Page 11, Line 10 – Page 12, Line 3; Page 26, Line 5 - Page 27, Line 8; Page 47, Line 20- Page 48, Line 2; Page 49, Lines 19-20. Claims 1-58 are pending and under consideration, with claims 1, 16, 29, 56, 57 and 58 being independent.

Applicant graciously thanks the Examiner for the interview granted to Applicant's representative.

1. Claim Rejections under 35 U.S.C. § 112, ¶ 1

Claims 1-58 stand rejected under 35 USC §112, first paragraph as allegedly failing to comply with the enablement requirement. Applicant respectfully traverses this rejection and disagrees.

a. The Office Action Fails to Make a Proper Showing

First, MPEP 2106.01 specifically states that when an invention involving computer programming is rejected based on "the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. 112, ***the examiner must establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure*** to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation." MPEP 2106.01 (citing *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971)) (emphasis added and omitted).

Moreover, according to MPEP 2106.02, which specifically addresses "Disclosure in Computer Programming Cases," "[t]o establish a reasonable basis for questioning the adequacy of a disclosure, ***the examiner must present a factual analysis of a disclosure*** to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation. [*Id.* (emphasis added).] The Office Action fails to make such a showing. Accordingly, Applicant respectfully requests that the 112, ¶ 1 rejection be withdrawn.

b. The Specification is Enabling

Second, the Office Action only states that claim 1 fails to describe "providing an automation program." Applicant respectfully disagrees. The specification at page 20, lines 7-16 provide substantial detail regarding the automation program. This section states:

> Automation programs 490 may include macros, queries, modules, or similar programming that serve to automatically boot the system, open or close applications or software programs, send or receive files, utilize information or data, or similar tasks. These programs 490 may be programmed in any number of computer languages such as VISUAL BASIC FOR APPLICATIONS™, TURBO PASCAL™, Fortran, Cobol, C, Pascal, C++, or the like. The programs 490 may also be programmed using languages specific to computer applications. These programs can perform simple or complex functions. An example of a simple function is recording the copyright date, or ISBN number of the title material authored by the system. Such information can be automatically recorded in a table or the material.

Clearly, the automation program is enabled by at least this information.

Further, the Interview Summary notes that "Applicant's position was that the programs are made of numerous small rules, and as such a specific set of macro's could not be disclosed, yet still enables the invention." While this is somewhat true, it is not entirely accurate. The

programs are in part made up of all the tools disclosed in the specification, including small rules and those described in the specification at page 20, lines 7-16. It was not possible to list every conceivable set of macros that could be used, as the combinations are close to infinite. Moreover, clear, detailed flowcharts, along with detailed descriptions are provided. *See, e.g.*, Fig. 1-12. Furthermore, the specification spells out, for example, how text in a book, other audiovisual format of a book, or literary work is automatically authored, explaining in detail what the computer program does to create this work. *See, e.g.*, Page 26, Line 5 – Page 27, Line 8. The specification even gives an example of creating a book on a "Country Report," and how text for such a book is generated, using "[m]odules, queries, automation programs, and/or macros" using "logical manipulations, such as the generation of variable values or the search and replacement of variable values within text contained in the database or the material so as to author original content not present in the existing database, tables, forms, modules, macros or queries or templates." Page 26, Line 22 – Page 27, Line 3. In addition, "the system may alternatively include text based on probabilistic or fuzzy logic." Page 27, Lines 3-4. Thus, for example, the system could take information about a country from years 1995-2004 in a database, and create content, sentences or other audiovisual material projecting how that information would look for this country in 2005-2014 based on logical manipulations, probabilistic or fuzzy logic. Therefore, Applicant respectfully requests that the 112, ¶ 1 rejection be withdrawn.

c. One of Ordinary Skill in the Art has Found the Specification Enabling

Third, Christopher Chan, one of ordinary skill in this art, has reviewed the specification. After his review, he agreed that "the detailed specification of the above-referenced patent

application, including its figures, provides more than enough guidance to a person of ordinary skill in the art, at the time the application was filed, to successfully practice the claimed invention without resorting to undue experimentation." [*See, e.g.* Chan Declaration (attached), ¶ 6.] Accordingly, Applicant respectfully requests that the 112, ¶ 1 rejection be withdrawn.

d. Claim 48

The Office Action also specifically rejects dependent claim 48 under 35 USC §112, first paragraph. While Applicant disagrees with this rejection, as demonstrated above, in order to clarify the claimed invention, however, Applicant has amended claim 48. Accordingly, Applicant respectfully requests that the rejection of this claim also be withdrawn.

2. Claim Rejections under 35 U.S.C. § 112, ¶ 2

Claims 55 and 58 stand rejected under 35 USC §112, second paragraph as allegedly being indefinite. Applicant respectfully traverses this rejection and disagrees.

Claim 55 stands rejected for using the phrase "high level of complexity." While Applicant disagrees with this rejection, in order to clarify the claimed invention, however, Applicant has amended claim 55. Accordingly, Applicant respectfully requests that the rejection of this claim also be withdrawn.

Claim 58[1] stands rejected for using the phrase "similar unique identification . . . code." Examples of unique identification codes are provided for in the specification on Page 8, Lines 5 - 17. Thus, while Applicant disagrees with this rejection, in order to clarify the claimed invention,

[1] Claim 58 is not specifically rejected in the Office Action (claim 55 is identified), but based on the quoted claim language, Applicant assumes it is claim 58 that has been rejected.

however, Applicant has amended claim 58. Accordingly, Applicant respectfully requests that the rejection of this claim also be withdrawn.

3. Claim Rejections under Ardissono

Claims 1-2, 5-16, 20, 22-26, 28-29, 34-45, 53-55, and 58 stand rejected under 35 USC §102, as being unpatentable by "Exploiting user models fore personalizing news presentations" by Ardissono et al. ("Ardissono"). Claims 3-4, 17-19, 21, 27, 31-33, 46-52 and 56-57 stand rejected under 35 USC 103, as being unpatentable by Ardissono in view of information alleged to be well-known. Applicant respectfully traverses these rejections.

As stated in the Interview Summary, Applicant has agreed to, and has amended the claims to further distinguish Ardissono from the claimed invention. Ardissono is directed to a system that presents "the most appropriate set of news" from large repositories of news. [Ardissono, Abstract.] Ardissono makes a point of stating "it is important to notice that the structure we defined is shallow and is not very different from the one imposed by the software systems used in the editorial offices of some newspapers." [Ardissono, Section 3.] Ardissono notes that the news it provides already has author(s) and titles. [*Id.*] Conversely, the claimed invention requires "automatically authoring, using a computer, a book or other audiovisual format of the book" or "book or literary work." Moreover, the claimed invention requires the book, other audiovisioual format of a book, or literary work to include "content, sentences or other audiovisual material not in the at least one database file." Ardissono does not teach or disclose automatically authoring a book, other audiovisioual format of a book, or literary work to

include "content, sentences or other audiovisual material not in the at least one database file." The content in Ardissono has already been authored.

Furthermore, Ardissono teaches away from automatically authoring a book, other audiovisioual format of a book, or literary work. Ardissono provides a set of news to users – such a user would not likely want this information packaged in a book. Moreover, users of such a system likely receive the latest news on a daily basis – making sending them a book every day undesirable. For at least the reasons stated above, Ardissono fails to teach or suggest all the claim limitations of all of the pending claims; the rejections of these claims under 35 USC § 102 should be withdrawn, and these claims should be allowed.

With regard to the claims rejected under 35 USC § 103, the Office Action fails to meet its burden of establishing a prima facie case of obviousness based on objective evidence in the record. *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983); *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). Rather, the Office Action makes admissions that that the art of record fails to disclose or suggest several features of the claims, but attempts to correct these deficiencies with unsupported statements that certain features were "well-known and desired in the art at the time of the invention" or by taking "Official Notice." Such conclusory statements cannot be used as a basis of a rejection.

The Federal Circuit has recently reaffirmed that obviousness rejections based on assertions lacking evidentiary support in the record cannot stand. *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), the Federal Circuit vacated a Patent Office Board affirmance of an obviousness rejection because, rather than relying on objective evidence, the Patent Office

based its obviousness rejection on conclusory statements having no evidentiary support in the record. *Id.* at 1342-43. In doing so, the Federal Circuit made it abundantly clear that "subjective belief and unknown authority" and "[assertions of] common knowledge and common sense" are not "a substitute for evidence." *Id.* at 1343-44.

The Office Action's use of "official notice" is similarly improper. Official notice can only properly be used to establish facts that are capable of "instant and unquestionable demonstration as being well-known." *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). In contrast, official notice ***may not*** be used as "the principal evidence upon which a rejection is based," *id.*, 424 F.2d at 1088, or, as done here, as the motivation for combining or modifying references. *Ex Parte Grochowski*, No. 95-1343, slip op. at 5 (Bd. Pat. App. & Int. June 27, 1995). Thus, Appellant submits that rejections under 35 USC § 103 are conclusory statements unsupported by evidence of record that, by definition, cannot satisfy the Patent Office's burden of establishing a prima facie case of obviousness. *In re Lee*, 277 F.3d at 1343.

For at least the reasons stated above, Ardissono fails to teach or suggest all the claim limitations. Therefore, for at least the reasons stated above, the rejections of claims 1-58 should be withdrawn, and these claims should be allowed.

4. Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific issue or comment does not signify agreement with or concession of that issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been

expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

All of the pending claims are now in condition for allowance. A formal notice to that effect is respectfully solicited. Applicant respectfully requests that all claims be allowed. In the event any fees are due, the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 06-1050.

Respectfully submitted,

Date: February 16, 2005

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